IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Art Unit: 3627

Shelton Louie et al. Conf. No. 5706

PRESCRIPTION ORDER POSITION TRACKING SYSTEM AND METHOD

Application No: 09/715,439

Filed: November 16, 2000

Examiner: Frenel,Vanel.

ASSISTANT COMMISSIONER FOR PATENTS
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office action dated September 4, 2007, applicants submit the following remarks for consideration in connection with a pre-appeal brief request for review being filed herewith.

Claims 1-2, 4-6, 62-63 stand rejected under 35 USC § 103 for obviousness over previously cited U.S. Pat. No. 6,611,806 to Harvey ("Harvey") in view of U.S. Pat. No. 5,771,657 to Lasher ("Lasher"), and further in view of newly cited U.S. Pat. No. 5,593,267 to McDonald et al. ("McDonald"). Claims 1 and 62 are in independent form. This request for review is directed specifically to independent claims 1 and 62. Review of the rejection of dependent claims 2, 4-6, and 63 may stand or fall with independent claims 1 and 62. Applicants submit that the rejections are improper and should be reversed for the following reasons.

The present invention relates to a system for tracking the physical locations of prescription orders as they are moved through a pharmacy. The conventional manual operation of a retail pharmacy, in which large numbers of prescriptions are processed and moved by hand, is described in the application from page 1, line 17 to page 2, line 18. Difficulties that can arise with the conventional manual handling of prescriptions in a retail pharmacy include prescriptions being inadvertently misplaced (application page 3, lines 3-5) or the locations of prescriptions not being correctly recorded (application page 3, lines 19-27) in a manual tracking system. As noted at application page 4, lines 1-15, some pharmacy vendors have attempted to automate the prescription filling aspect of a pharmacy by incorporating an automatic assembly line machine for filling prescription orders, but these automated, conveyor-based systems are overly expensive for use in a retail pharmacy environment and occupy excessive amounts of the limited space available

within pharmacy work areas.

Claims 1 and 62 are in independent form. Each claim recites (1) manually filling and storing the prescription orders and automatically tracking their positions, (2) moving prescription orders by hand to or from two different areas within a pharmacy, (3) operably securing a separate machine-readable tag to each prescription order, the tag being readable by a tag reader regardless of the tag orientation relative to the tag reader, and (4) automatically reading the tags to detect the location of each prescription order within the two different areas.

As stated at page 8 of the 5/27/2008 amendment, Harvey is directed to a computer system for listing the lot numbers of pharmaceuticals that are administered to patients. Harvey is directed to:

> "quickly and efficiently track[ing] the patients to whom pharmaceuticals, such as blood derivatives, have been administered. (Emphasis added.) … When it is desired to track certain lot numbers of a pharmaceutical to the patients to whom they have been administered, there often are no records that can be consulted." (Harvey, col. 1, lines 10-34.)

Despite clearly and explicitly being directed to listing pharmaceuticals the have already been dispensed to patients, and are no longer within a pharmacy, the Examiner states at page 3 of the 9/4/2008 office action that "Harvey discloses a method for tracking prescription orders through a pharmacy."

As stated at page 8 of the 5/27/2008 amendment, Lasher is directed to an automatic prescription dispensing and packing system. The extent of the automation of the Lasher system is summarized at Lasher col. 1, line 56 to col. 2, line 5. At page 4 of the 9/4/2008 office action the Examiner cites Lasher as disclosing "manually moving the prescription order to one of the compartments in the array of compartments as a filled prescription order [each] compartment having a corresponding compartment tag reader." Applicants note that the word "each," which is included in the claim, was omitted from the rejection.

Newly cited McDonald, like Lasher, is directed to an automated system for selecting and delivering packages from a storage area. At page 5 of the 9/4/2008 office action the Examiner cites Lasher as disclosing "moving prescription orders by hand to a second location," but the figures cited by the Examiner show various views of a "gripper assembly," and the specification passages cited by the Examiner describe a "picking means" or the gripper assembly. McDonald describes use of bar codes and a single bar code reader.

Applicants submit that the rejections of claim 1 and 62 are improper and should be reversed because the cited references fail to teach or suggest every feature recited in the claims.

Applicants submit that Harvey's listing of the lot- or batch-numbers of pharmaceuticals that

have been dispensed to patients does not relate to the manner in which prescription orders are filled within a pharmacy. Lasher is directed to an automatic prescription dispensing and packing system, and McDonald is similarly directed to an automated system for selecting and delivering packages from a storage area. While manual filling and storing prescription orders are known in the art, Harvey is silent as to the manner of filling and storing orders, and the automated systems of Lasher and McDonald are directed away from manual filling and storage. Even the minor example of manual handling described in Lasher is not directed to manual storage of prescription orders. (See page 14 of the 5/27/2008 amendment, Lasher col. 13, lines 18-46.) Applicants submit, therefore, that there is no suggestion to combine the cited references to achieve a system with manual handling and storage of prescription orders and automated position tracking, as recited in the claims.

Applicants submit that Harvey's listing of the lot- or batch-numbers of pharmaceuticals that have been dispensed to patients does not relate to tracking the physical locations of prescription orders within a pharmacy. Harvey is directed to listing the pharmaceuticals that have left the pharmacy, not to the locations of prescription orders within a pharmacy. Also, applicants explain at pages 10-13 of the 5/27/2008 amendment that Harvey and Lasher fail to teach or suggest "operably securing a machine-readable tag to each prescription order." Although not cited in the office action, McDonald does describe the use of bar codes for identifying packages, but the reading of bar codes is dependent upon their orientation. For example, a bar code must be facing the bar code reader to be read. Accordingly, applicants submit that the cited references do not teach or suggest operably securing a machine-readable tag to each prescription order, the tag being readable by a tag reader regardless of the tag orientation relative to the tag reader.

The cited references do not teach or suggest automatically reading the tags to detect the location of each prescription order within two different areas. Harvey is directed to listing the pharmaceuticals that have left the pharmacy, not to the locations of prescription orders within a pharmacy. The automated system of Lasher includes a carrier of multiple prescriptions that is identified, but there is no separate identification of each prescription within the carrier and so no actual tracking of separately tagged prescription orders. The tracking in Lasher of a carrier with multiple separate prescriptions reflects the fully automated nature of the Lasher system and the absence of a need to prevent human errors that can arise with the handling of individual prescription orders. Likewise, the automated, computer-controlled conveyance in McDonald allows a single bar code reader to track packages without the potential for human handling errors and also allows the use of bar codes because packages can be automatically placed in a predetermined orientation to read the bar codes.

None of the cited references teaches or suggests moving prescription orders by hand to or from two different areas within a pharmacy. Harvey is directed to listing the pharmaceuticals that have left the pharmacy, not to the locations of prescription orders within a pharmacy. Lasher is directed to an automatic prescription dispensing and packing system, and McDonald directed to a similar automated system for selecting and delivering packages from a storage area. Lasher describes some manual handling of exceptional prescriptions, but not manual handling to or from two different areas within a pharmacy. (See page 14 of the 5/27/2008 amendment, Lasher col. 13, lines 18-46.) The Examiner's citation to a fully automated transport mechanism in McDonald as disclosing the moving of prescription orders by hand seems to have overlooked the explicit claim language and the operational context that it provides. Applicants submit, therefore, that cited art fails to teach or suggest moving prescription orders by hand to or from two different areas within a pharmacy.

For the foregoing reasons applicants request that the rejections of claims 1 and 63, and their dependent claims, be reversed.

Claims 44-51 stand rejected under 35 USC § 103 for obviousness over previously cited U.S. Pat. No. 6,611,806 to Harvey ("Harvey") in view of U.S. Pat. No. 5,771,657 to Lasher ("Lasher"), and further in view of newly cited U.S. Pat. No. 6,448,886 to Garber et al. ("Garber"). Claim 44 is in independent form. This request for review is directed specifically to independent claim 44. Review of the rejection of dependent claims 45-51 may stand or fall with independent claim 44. Applicants submit that the rejections are improper and should be reversed for the following reasons.

Claim 44 recites the subject matter of claims 1 and 63, and the Examiner rejects claim 44 over Harvey and Lasher for the reasons set forth with regard to claims 1 and 63. Applicants submit that claim 44 is also distinct from Harvey and Lasher for the reasons above with regard to claims 1 and 63. In addition, applicants submit that claim 44 is distinct from the combination of Harvey, Lasher, and Garber.

Garber is directed generally to radio frequency identification devices, or RFID devices. The Examiner cites at page 9 of the 9/4/2008 office action a passage of Garber relating to using RFID devices to track books on a library shelf.

Applicants submit that Harvey's listing of the lot- or batch-numbers of pharmaceuticals that have been dispensed to patients does not relate to tracking the physical locations of prescription orders within a pharmacy. Lasher is directed to an automatic prescription dispensing and packing system that tracks batches of prescriptions within a carrier. Lasher does not remotely hint at tracking individually tagged prescriptions. In this context, the Examiner cites a passage describing

the use of RFID devices to identify books on a library shelf. Applicants note, however, that Harvey is silent as to the positioning of prescriptions with in pharmacy, and the automated system of Lasher and the Dewey Decimal System (for example) of a library would lead one skilled in the art away from "worker selected storage areas," as recited in the claim. Also, the claim recites that each worker selected storage area has a tag reader, while the library example cited by the Examiner is directed to a handheld RFID device that is used throughout a library. (Lasher, col. 17).

For the foregoing reasons applicants request that the rejections of claim 44 and its dependent claims be reversed.

Applicants acknowledge the rejection under 35 USC 112, second paragraph, of claims 1 and 62. Upon reversal of the obviousness rejections, applicants will correct the claims by deleting the word "remote" in an amendment to be filed with a Request for Continued Examination.

Applicants appreciate the pre-appeal brief review and believe rejections for obviousness should be REVERSED.

Respectfully submitted,

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